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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,476	12/12/2003	Arnold J. Levine	10434/61302	9604
26646	7590	07/26/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			DUFFY, BRADLEY	
			ART UNIT	PAPER NUMBER
			1643	
DATE MAILED: 07/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,476

Applicant(s)

LEVINE, ARNOLD J.

Examiner

Brad Duffy

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-68 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12 and 51-53, drawn to a vaccine composition comprising mutant p53 or mutant p53 truncations, classified in class 530, subclass 300.
 - II. Claims 13-24 and 54-56, drawn to method of inhibiting the growth of tumors in mammals using a vaccine composition comprising mutant p53 or mutant p53 truncations, classified in class 424, subclass 155.1.
 - III. Claims 25 and 57-59, drawn to recombinant antigen presenting cells that express exogenous DNA encoding mutant p53 protein or mutant p53 protein truncations, classified in class 435, subclass 362.
 - IV. Claims 26-37 and 60-62, drawn to a vaccine composition comprising wild-type p53 or wild-type p53 truncations, classified in class 530, subclass 350.
 - V. Claims 38-49 and 63-65, drawn to method of inhibiting the growth of tumors in mammals using a vaccine composition comprising wild-type p53 or wild-type p53 truncations, classified in class 424, subclass 174.1.
 - VI. Claims 50 and 66-68, drawn to recombinant antigen presenting cells that express exogenous DNA encoding wild-type p53 protein or wild-type p53 protein truncations, classified in class 435, subclass 252.3.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and III, and Groups IV and VI are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product^{of} Group^s III and Group VI are deemed to be useful as a source for producing mutant and wild-type p53 proteins, respectively, and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

The inventions are independent or distinct, each from the other because:

Inventions of Group I and Group IV represent separate and distinct products, which are made by materially different methods, and are used in materially different methods, which have different modes of operation, different functions and different effects. The polypeptides in the vaccine composition of Groups I and IV are patentably distinct because they are structurally and functionally distinct. For example, since there are admitted primary amino acid sequence differences and tertiary protein structure is dependent on primary protein structure there is distinctness structurally. Secondly, changes in protein structure cause changes in protein function that at the minimum alter functional parameters and at the maximum produce a protein with the opposite effect of its wild-type function. Therefore art on mutant p53 would not necessarily be art on wild-type p53, as they have acquired a separate status in the art because of their recognized divergent subject matter. The examination of all groups would require different

searches in the U.S. Patent shoes and the scientific literature and would require the consideration of different patentability issues. Thus, inventions of Group I and IV are separate and distinct in having different method objectives, method steps, parameters, reagents used and different endpoints and are patentably distinct.

Similarly, the Inventions of Group III and Group VI represent separate and distinct products, which are made by materially different methods, and are used in materially different methods, which have different modes of operation, different functions and different effects. These Groups restrict the mutant p53 antigen presenting cells from the wild-type p53 antigen presenting cells for the reasons given above to restrict Group I and Group IV.

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the composition of Group I could be used in a materially different method such as raising antibodies to mutant p53, which differs in the method objective, method steps, parameters, reagents used and endpoint from the therapeutic method of Group II.

Inventions of Group IV and Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially

different process of using that product. See MPEP § 806.05(h). In the instant case, the composition of Group IV could be used in a materially different method such as raising antibodies to wild-type p53, which differs in the method objective, method steps, parameters, reagents used and endpoint from the therapeutic method of Group V.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classifications, restriction for examination purposes as indicated is proper.

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is

Art Unit: 1643

found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.


Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brad Duffy whose telephone number is (571) 272-9935. The examiner can normally be reached at Monday through Friday from 7:00 AM to 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Larry Helms, can be reached at (571) 272-0832. The official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,
Brad Duffy 
571-272-9935

